Attorney Docket No. RSW920030090US1 (7161-103U)                                    **PATENT**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of                      :   Customer Number:  46320
                                          :
David KAMINSKY, et al.                    :   Confirmation Number:  1386
                                          :
Application No.:  10/635,598              :   Group Art Unit:  2451
                                          :
Filed:  August 6, 2003                    :   Examiner:  K. Tang
                                          :
For:    INTELLIGENT MAIL GATEWAY          :


## REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:


This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated October 28, 2008.


The Examiner's response to Appellants' arguments submitted in the Second Appeal Brief

of August 8, 2008 (hereinafter the Second Appeal Brief), raises additional issues and underscores

the factual and legal shortcomings in the Examiner's rejection.  In response, Appellants rely upon

the arguments presented in the Second Appeal Brief, and the arguments set forth below.

1                                              **<u>REMARKS</u>**

2

3          Appellants have compared the statement of the rejection found on pages 3-8 of the

4     Examiner's Answer with the statement of the rejection found on pages 2-7 of the Third Office

5     Action.  Upon making this comparison, Appellants have been unable to discover any substantial

6     differences between the respective statements of the rejection.  As such, Appellants proceed on

7     the basis that the Examiner's sole response to Appellants' Second Appeal Brief is found on pages

8     9-16 of the Examiner's Answer.

9

10          <u>Non-Compliant Examiner's Answer</u>

11          On page 8 of the Second Appeal Brief, Appellants pointed out where the Examiner's

12    Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the

13    Examiner has completely ignored this requirement.  As noted throughout the prosecution of this

14    application and in the Second Appeal Brief, the Examiner has failed to properly establish the

15    facts underlying the Examiner's analysis.  Appellants' position is that these omissions in the

16    Examiner's prima facie analysis are correctable by the Examiner, and the correction of these

17    omissions would help both Appellants and the Honorable Board gain a better understanding of

18    the alleged findings of facts and analysis employed by the Examiner in rejecting the claims.

19    Thus, Appellants respectfully recommend that the Honorable Board remand the present

20    application to the Examiner to address these omissions.[1]

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[1] The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. E.g., <u>Ex parte Daleiden</u>, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); <u>Ex parte Rozzi</u>, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); <u>Ex parte Gambogi</u>, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); <u>Ex parte Jones</u>, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); <u>Ex parte Schricker</u>,

1

2          Objection to the Specification

3          As noted in the Second Appeal Brief, Appellants recognize that this is not an appealable

4    issue. However, since the Examiner chose to address Appellants' arguments on page 9 of the

5    Examiner's Answer, Appellants will respond in kind.

6

7          There is no absolute requirement for "antecedent basis" for all of the claim terms.

8    Instead, 37 C.F.R. § 1.75(d)(1) states that "the terms and phrases used in the claims must find

9    clear support **or** antecedent basis in the description so that the meaning of the terms in the claims

10   may be ascertainable by reference to the description." Thus, clear support, in the specification,

11   for a claim term can satisfy the requirements of 37 C.F.R. § 1.75(d)(1).

12

13         In this regard, the Examiner is also referred to M.P.E.P. § 2173.05(e), which under the

14   heading "A claim term which has no antecedent basis in the disclosure is not necessarily

15   indefinite" states the following:

16         The mere fact that a term or phrase used in the claim has no antecedent basis in the specification
17         disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement
18         that the words in the claim must match those used in the specification disclosure. Applicants are
19         given a great deal of latitude in how they choose to define their invention so long as the terms and
20         phrases used define the invention with a reasonable degree of clarity and precision. (emphasis
21         added)
22
23   Also, original claims constitute their own description. In re Koller, 613 F.2d 819, 204 USPQ 702

24   (CCPA 1980). At the current time, over 1,500 patents have issued with at least one claim

25   including the phrase "machine readable storage." Given the widespread use of these terms,

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56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the
rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Braeken, 54 USPQ2d 1110, 1112-
13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

1    Appellants' position is that one having ordinary skill in the art would not require a definition and

2    would have no trouble discerning a meaning for these terms simply based of the term itself.

3    Therefore, Appellants respectfully submit that the Examiner's objection is not proper.

4

5    <u>Rejection under 35 U.S.C. § 101</u>

6        In response to the arguments presented on pages 5-7 of the Second Appeal Brief, the

7    Examiner asserted the following in the paragraph spanning pages 10 and 11 of the Examiner's

8    Answer:

9            Appellant allegedly stated that Claims 1-4 are statutory. However, as stated in the office
10           action, appellant's specification (see page 11, par 0023) has evidently stating that the invention
11           (e.g., an intelligent electronic mail (e-mail) gateway) can be realized in "software". Further, an
12           intelligent e-mail gateway comprising: a message store configured to (a software module) and a
13           notification manager (a software module), thus, a intelligent e-mail gateway comprising only
14           software modules are considered to be a software per se, which does not fall in any statutory
15           category.
16
17   At the outset, Appellants note that the Examiner has <u>completely ignored</u> Appellants' arguments

18   presented in the Second Appeal Brief.  For example, the Examiner has ignored Appellants'

19   arguments that a "message store" is a device, and the Examiner's has ignored the Federal

20   Circuit's analysis within <u>In re Comiskey,</u> which would have come out differently had the

21   Examiner's analysis would have been employed.

22

23       Instead, the Examiner asserts that the claimed "message store" is a software module –

24   <u>without factual support</u> and then asserts that the claimed "notification manager" is a software

25   module – also <u>without factual support</u>.  The Examiner's analysis is completely bereft of factual

26   findings.  Instead, the Examiner's analysis is solely based upon the naked assertion that all the

27   limitations are software per se.

28

1    Based upon the Examiner's analysis, it is readily apparent that the Examiner

2    misunderstands exactly what constitutes software *per se*.  In particular, Appellants respectfully

3    submit that the Examiner is confused as to exact meaning of the phrase "per se."  The definition

4    of legal term "per se" is the following:[2]

5    By itself; in itself; taken alone; by means of itself; through itself; inherently; in isolation;
6    unconnected with other matters; simply as such; in its own natures without reference to its
7    relation.
8
9    Thus, software *per se* is an abstract idea embodied by the software alone without anything else.

10   For this reason, software *per se* is deemed to be non-statutory subject matter.

11

12   However, as evident from Figure 1 of Appellants' disclosure, the notification manager

13   200 and the message store 180 are not "in isolation; unconnected with other matters," as implied

14   by the Examiner's assertion as to "software per se."  Instead, Figure 1 clearly shows that both the

15   notification manager 200 and the message store 180 are integrally tied into the mail gateway 140,

16   which is clearly illustrated in Figure 1 as being a computer device.  Thus, the claimed invention,

17   as a whole, and given the broadest, reasonable meanings of the claim terms, is directed to

18   statutory subject matter, and thus meets the requirements of 35 U.S.C. § 101.

19

20   <u>Rejection of claim 1 under 35 U.S.C. § 102</u>

21   On pages 10 and 11 of the Second Appeal Brief, Appellants raised several issues with

22   regard to the Examiner's rejection of claim 1 based upon Tomkow.  The Examiner's response to

23   Appellants' arguments is found on pages 10-12 of the Examiner's Answer.

24

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[2] Black's Law Dictionary 1142 (6th ed. 1990).

5

1   After Appellants argued that the Examiner's analysis was unclear as to the specific

2   teachings with Tomkow being relied upon to teach the specific elements being claimed, the

3   Examiner made the following assertions on pages 10 and 11 in which the Examiner alleged the

4   following mappings between claimed elements and the teachings of Tomkow:

5       mail server (element 16, refer to Fig 3)
6       e-mail gateway (element 14, refer to Fig 3)
7       server RPost server 14 is capable to store messages forwarded by recipients.
8       notification manager is a functionality provided by Tomkow's RPost server 14
9

10   On page 10 of the Second Appeal Brief, Appellants argued that "the Examiner can only

11   rely upon RPost server 16 to teach the claimed mail server since RPost server 14 is not

12   associated with the corresponding intended recipients." The Examiner responded to this

13   argument by citing paragraph [0150] of Tomkow and asserting the following "the message store

14   is associated with the corresponding intended recipients" on page 11 of the Examiner's Answer.

15   For ease of reference, paragraph [0150] of Tomkow is reproduced below:

16       3. the quoted body of the original message together with the e-mail addresses of its intended
17       recipients.
18
19   Although this passage is not clear as to the context of what is being described, paragraph [0147]

20   describes that a receipt 20 includes (1) an identifier (see paragraph [0148]); (2) a date and time

21   (see paragraph [0149]; (3) the description reproduced above; (4) another date and time (see

22   paragraph [0151]); and (5) a table (see paragraphs [0152]-[0157]). As described in paragraph

23   [0147], receipts are "e-mails sent to the original sender of the made-of-record message."

24

25   Thus, to teach the claimed "message store ... associated with corresponding intended

26   recipients," the Examiner relies upon a teaching describing the contents of a receipt (i.e., an e-

27   mail from a recipient to a sender). Entirely absent from the Examiner's cited passage is any

28   mention of (i) a message store; (ii) the message store being associated with intended recipients.

6

1    Not only has the Examiner failed to establish that the Examiner's cited passage teaches the

2    limitations for which the Examiner is asserting that this passage teaches, the Examiner has failed

3    to set forth any claim construction that explains why the Examiner believes that the limitations at

4    issue are identically disclosed by paragraph [0150] of Tomkow.

5

6    A perfect analogy to the claimed "message store ... associated with corresponding

7    intended recipients" would be a run-of-the-mill store the provides rental mail boxes (e.g., Mail

8    Boxes Etc., UPS store, etc.)  Once a user has rented a mail box, the specific store (at a specific

9    location) acts as a message store associated with corresponding intended recipients.  The analogy

10   to the RPost server 16, however, is a post office or a communal outgoing mail box, from which

11   mail to be sent is received.  These entities, however, are not "associated with corresponding

12   intended recipients."  Thus, one having ordinary skill in the art would recognize that the RPost

13   server 16 fails to identically disclose all of the limitations recited in claim 1.

14

15   _____

16   In the second full paragraph on page 11 of the Second Appeal Brief, Appellants argued

17   that paragraph [0097] of Tomkow does not teach the limitations associated with the claimed

18   "notification manager."  However, as noted earlier, Appellants proceeded under the assumption

19   that the Examiner was relying upon RPost server 16 to teach the claimed mail server (and thus

20   the notification manager) since RPost server 14 is not associated with the corresponding intended

21   recipients.  Referring to page 12 of the Examiner's Answer, the Examiner asserted the following:

22       The specific teaching could be found in Tomkow, par 0229, where "the notification
23       information receipt that RPost will generate for the sender". Furthermore, Tomkow disclosing
24       RPost 14 comprising functionality to notify senders the status when the message is un-able to send
25       to the recipient, see paragraph 0144, 0145, 0158, and specifically 0177.
26

1   Absent from the Examiner's cited passages, however, is a teaching that corresponds to the

2   claimed "notifying selected ones of said senders when delivery to said intended recipients has

3   become impaired" (emphasis added). Based upon the plain language of the claim, not all senders

4   are necessarily notified when delivery has become impaired. Instead, selected ones of the

5   senders are notified. None of the Examiner's cited passages teach these limitations. Thus, the

6   Examiner has further failed to establish that Tomkow identically discloses all of the limitations

7   recited in claim 1 within the meaning of 35 U.S.C. § 102.

8

9       Rejection of claim 2 under 35 U.S.C. § 103

10      In the first full paragraph on page 12 of the Second Appeal Brief, Appellants presented

11  separate arguments as to dependent claim 2. The Examiner's response to these arguments is

12  found on pages 12 and 13 of the Examiner's Answer and is reproduced below:

13          As already admitted in its argument by Appellant that the Horvitz teaches the concept of
14          an alternate e-mail address, Horvitz further discloses that the its system is capable to present users
15          an additional contact information such as an additional e-mail address when the user cannot be
16          reached see par 0277.
17
18  The Examiner's appears to have miscomprehended Appellants' argument that "absent from the

19  Examiner's cited passage is teachings as to the remainder of the limitations associated with the

20  alternate e-mail address."  Specifically, the "remainder of the limitations" are underlined –

21  "associated with the alternate e-mail address with which said selected ones of said senders can

22  retransmit said messages to corresponding intended recipients."  Again, the concept of the

23  "selected ones of said senders" is being claimed yet both the Examiner's analysis and the

24  teachings of Horvitz are completely silent as to these limitation.  Moreover, as claimed, the

25  senders retransmit the messages.  On the contrary, the router system 420 of Horvitz provides the

26  routing.  Referring to Fig. 24, Horvitz clearly indicates that the routing system 420 is separate

1 from the sender since the routing system sends a reply to the sender, which would not be

2 required if the routing system and sender were one and the same.

3

4 Therefore, for the reasons submitted above, Appellants maintain that the Examiner has

5 mischaracterized the scope and content of Horvitz.

6

7 <u>Rejection of claim 12 under 35 U.S.C. § 103</u>

8 In the second full paragraph on page 12 of the Second Appeal Brief, Appellants presented

9 separate arguments as to dependent claim 12. The Examiner's response to these arguments is

10 found on page 13 of the Examiner's Answer and is reproduced below:

11 According to the Appellant's claim limitation, the limitation does not further define what
12 is" the nature of the impairment)." Tomkow teaches the alleged missing limitation. Tomkow
13 discloses the notification send to sender disclosing the delivery has "failed" in par 0155. Tomkow
14 further discloses the notification/delivery receipts of its system contains details information such
15 as the delivery status, see par 0177. The mapping is comparable to the claimed "nature of said
16 impairment" and is reasonably compared and reasonably interpreted.
17
18 Although the Examiner asserts that the claimed limitations have been reasonably interpreted, this

19 is a self-serving conclusory statement. Based upon the plain language of "nature of said

20 impairment," there are <u>two</u> characteristics being described: (i) the *impairment* and (ii) the *nature*

21 of the impairment. As argued in the Second Appeal Brief, the teachings of Tomkow only

22 describe a single characteristic (i.e., the delivery has failed). Thus, the Examiner has not

23 properly interpreted the language of the claims and since the Examiner's analysis is based upon

24 an improper claim construction, the Examiner has committed reversible error by not properly

25 comparing the claimed limitations to the teachings of the applied prior art. Moreover, the

26 applied prior art fails to teach the limitations for which the Examiner is relying upon the applied

27 prior art to teach.

28

1      <u>Rejection of claim 13 under 35 U.S.C. § 103</u>

2      In the third full paragraph on page 12 of the Second Appeal Brief, Appellants presented

3     separate arguments as to dependent claim 13. The Examiner's response to these arguments is

4     found on pages 13 and 14 of the Examiner's Answer and is reproduced below:

> 5   Tomkow teaches the formatting a notification comprising a statement of said impairment
> 6   and forwarding said detailed notification to said identified senders see par 0147-0162 and par
> 7   0177. Tomkow did not explicitly disclosing "an estimate of when normal mail delivery can
> 8   resume." However, Horvitz discloses a similar teaching of formatting a notification comprising the
> 9   alleged missing claim limitation: "an estimate of when normal mail delivery service can resume".
> 10  Specifically, Horvitz discloses that "the expected time to return determination by the system may
> 11  be automatically conveyed to senders of highly urgent messages, for example. In this manner,
> 12  message sender receive feedback when the user is expected to return such that he or she can reply
> 13  to the messages." see par 0268. Lines 7-12. This means that Horvitz teaches an estimated (i.e.,
> 14  feedback when the user is expected to return) of when normal mail delivery service can resume
> 15  (i.e., the user is expected to return such that she/he can reply to the message. The expected return
> 16  of the user will allow she/he to begins again (resume) reply to the messages thus allowing the
> 17  system to send the reply message back to the sender (normal mail delivery service). It is the
> 18  combination of Tomkow in view of Horvitz that discloses the alleged missing limitations.

19

20    To be clear, the limitation at issue is "an estimate of when normal mail delivery service can

21   resume."

22

23      Referring to the above-reproduced passage, the Examiner's both presented <u>new</u> analysis

24   and a <u>new</u> citation within Horvitz. Specifically, the Examiner cited paragraph [0268] of Horvitz,

25   which is reproduced below:

> 26   A notification and/or alerting system may also estimate <u>when the user is expected to</u>
> 27  <u>return,</u> such that it transmits priorities that are expected to be important before the user is expected
> 28  to return. This can be achieved by learning user-present and user-away patterns over time. The
> 29  user can then set suitable policies in terms of when he or she is expected to return to the system to
> 30  review the priorities without being alerted to them. The expected time to return determination by
> 31  the system may be automatically conveyed to senders of highly urgent messages, for example. In
> 32  this manner, message senders receive feedback when the user is expected to return such that he or
> 33  she can reply to the messages. The sender may also be informed that his or her message has been
> 34  conveyed to the user's mobile device, and so forth.

35

36    The Examiner correctly points out the Horvitz teaches an "estimate." However, the Examiner

37   incorrectly alleges that Horvitz teaches the other limitations for which the Examiner has admitted

38   that Tomkow fails to teach. Specifically, the "estimate" described by Horvitz is of "when the

1    user is expected to return." In contrast, the claimed estimate is "when normal mail delivery

2    service can resume." These are two <u>entirely different</u> estimates.

3

4          Returning to the analogy of "snail mail," the concept of "normal mail delivery service,"

5    given its plain and ordinary meaning to one skilled in the art, simply means that the mail has

6    been delivered to its intended recipient. Moreover, for normal mail delivery service "can

7    resume," as claimed, the normal mail delivery service must have been impaired (e.g., stopped).

8    The teachings of Horvitz, however, does not contemplate the need for normal mail delivery

9    service to be resumed since the normal mail delivery service has not been impaired. Whether or

10    not a recipient of e-mail (or "snail mail") is available to read the mail is immaterial to whether or

11    not "normal mail delivery service" exists. The Examiner's unstated claim construction ignores

12    that the service is a <u>delivery</u> service. Thus, estimates as to mail reading (i.e., dependent upon

13    when a user is expected to return) are not relevant to the claimed limitations.

14

15          Therefore, the Examiner has not properly interpreted the language of the claims and since

16    the Examiner's analysis is based upon an improper claim construction, the Examiner has

17    committed reversible error by not properly comparing the claimed limitations to the teachings of

18    the applied prior art. Moreover, the applied prior art fails to teach the limitations for which the

19    Examiner is relying upon the applied prior art to teach.

20

21

1      Rejection of claim 7 under 35 U.S.C. § 103

2      On page 13 of the Second Appeal Brief, Appellants presented separate arguments as to

3   dependent claim 7. The Examiner's response to these arguments is found on page 15 of the

4   Examiner's Answer and is reproduced below:

5          Delaney, similarly teaches that "consulting a data store of the state information for
6      selected ones of said respective mail servers to recall an already identified impairment".
7      Specifically, Delaney's transaction server 150 checks (consults) the storage (data store) of
8      recipients schedule (state information) for database 152 (selected one of said respective mail
9      servers) to retrieve (to recall) customers specified (already identified) unavailability to receive
10     (e.g., blackout period) (i.e., impairment associated with the customers), see par 0058 and 0059.
11     Therefore, the combination of Tomkow in view of Delaney teach the limitation of consulting a
12     data store of the state information for selected ones of said respective mail servers to recall an
13     already identified impairment. (emphasis added)
14
15   Although apparently not recognized by the Examiner, the term "state information" is an

16   extremely well-known term of art. State information refers to the operational properties (i.e.,

17   "state") of the "respective mail servers." However, the Examiner's alleged state information

18   refers to properties of the customers. Specifically, the information identified by the Examiner

19   has nothing to do with the properties of the "respective mail servers." Instead, the alleged state

20   information taught by Delaney is of the customers.

21

22      Therefore, the Examiner has not properly interpreted the language of the claims and since

23   the Examiner's analysis is based upon an improper claim construction, the Examiner has

24   committed reversible error by not properly comparing the claimed limitations to the teachings of

25   the applied prior art. Moreover, the applied prior art fails to teach the limitations for which the

26   Examiner is relying upon the applied prior art to teach.

27

For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101-103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 29, 2008

Respectfully submitted,

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